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MARTIN & FERRARO, LLP 1557 LAKE OPINES STREET, NE HARTVILLE, OH 44632			WOODALL, NICHOLAS W	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GARY K. MICHELSON

Appeal 2009-015030
Application 10/675,820
Technology Center 3700

Before TONI R. SCHEINER, DONALD E. ADAMS, and
STEPHEN WALSH, *Administrative Patent Judges*.

ADAMS, *Administrative Patent Judge*.

DECISION ON APPEAL¹

This appeal under 35 U.S.C. § 134 involves claims 1-30, the only claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

The claims are directed to a guard. The claims have not been argued separately and therefore stand or fall together. 37 C.F.R. § 41.37(c)(1)(vii). Claim 1 is representative and is reproduced in the “Claims Appendix” of Appellant’s Brief.

Claims 1-28 stand rejected under 35 U.S.C § 103(a) as unpatentable over the combination of Cauthen² and Thompson.³

Claim 29 stands rejected under 35 U.S.C § 103(a) as unpatentable over the combination of Cauthen, Thompson, and Gruskin.⁴

Claim 30 stands rejected under 35 U.S.C § 103(a) as unpatentable over the combination of Cauthen, Thompson, and Mansouri.⁵

We affirm.

ISSUE

Does the preponderance of evidence on this record support a conclusion of obviousness?

FINDINGS OF FACT

FF 1. We adopt the Examiner’s factual findings as our own.

FF 2. Thompson’s apparatus is configured to provide three apertures “to allow access to the patient’s cervix when the examination apparatus . . . is in use” (Thompson, col. 2, ll. 38-40; *see also* Ans. 6 (“Thompson is also a surgical device that distracts and provides access to a surgical site”)).

²Cauthen, US 2003/0135220 A1, published July 17, 2003.

³Thompson, US 5,846,249, issued December 8, 1998.

⁴Gruskin et al., US 2003/0023209 A1, published January 30, 2003.

⁵Mansouri et al., US 2003/0229401 A1, published December 11, 2003.

PRINCIPLES OF LAW

“A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.” *In re Clay*, 966 F.2d 656, 659 (Fed.Cir.1992). In other words, “familiar items may have obvious uses beyond their primary purposes.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 127 S.Ct. 1727, 1742, 167 L.Ed.2d 705 (2007). We therefore have concluded, for example, that an inventor considering a hinge and latch mechanism for portable computers would naturally look to references employing other “housings, hinges, latches, springs, etc.,,” which in that case came from areas such as “a desktop telephone directory, a piano lid, a kitchen cabinet, a washing machine cabinet, a wooden furniture cabinet, or a two-part housing for storing audio cassettes.” *Paulsen*, 30 F.3d at 1481-82.

In re ICON Health and Fitness, Inc., 496 F.3d 1374, 1379-1380 (Fed.Cir. 2007).

Arguments not made are waived. See 37 C.F.R. § 41.37(c)(1)(vii) (“Any arguments or authorities not included in the brief or a reply brief ... will be refused consideration by the Board, unless good cause is shown.”).

ANALYSIS

Appellant contends that Thompson’s speculum is used to facilitate the dilation of soft tissue, whereas the guard of independent claim 1 is for use with bone (App. Br. 4; *see also* Reply Br. 2-3). From this Appellant contends that “Thompson is non-analogous art to the claimed invention” (*id.*). We are not persuaded. Cauthen, Thompson, and the invention of Appellant’s claim 1 all relate to a medical apparatus that articulates about a pivot point. As such we find that a person of ordinary skill in this art interested in modifying the articulation point of Cauthen’s device would

have considered Thompson. In this regard, we find that Appellant does not dispute the Examiner's reason to modify Cauthen with the teachings of Thompson "to better use the device to distract the vertebrae" (Ans. 5).

Appellant contends that in contrast to the teachings of Thompson, Cauthen teaches that the articulating hinges "are positioned adjacent the leading ends of the insertion instruments" and "are disposed on the exterior of the hollow bodies" (App. Br. 8-9; *see also* Reply Br. 3-4). From this Appellant contends that "Cauthen and Thompson teach away from one another" (App. Br. 7 (emphasis removed); Reply Br. 3 (emphasis removed)). We are not persuaded. Appellant fails to support this contention with persuasive evidence or argument to support his conclusion that it would not have been obvious to modify Cauthen in the manner suggested by Thompson.

Appellant contends that if one of ordinary skill in this art modified Cauthen's apparatus with the teachings of Thompson, the passage way through the hollow body of Cauthen's apparatus "would be interrupted, and therefore, instruments could not be inserted therethrough" (App. Br. 9; *see also* Reply Br. 4-5). From this Appellant contends that "[t]he combination of Cauthen and Thompson is inoperable" (App. Br. 9 (emphasis removed); Reply Br. 4 (emphasis removed)). We are not persuaded. Thompson's apparatus comprises apertures to allow access through the apparatus into the patient (FF 2). Appellant fails to provide persuasive evidence or argument to support a conclusion that similar apertures would not be present in Cauthen's apparatus when modified by Thompson.

CONCLUSION OF LAW

The preponderance of evidence on this record supports a conclusion of obviousness. The rejection of claim 1 under 35 U.S.C § 103(a) as unpatentable over the combination of Cauthen and Thompson is affirmed. Claims 2-28 fall together with claim 1.

As for claims 29 and 30 Appellant relies on their arguments with regard to claim 1 (App. Brief 10; Reply Br. 5). For the foregoing reasons we are not persuaded. The rejection of claim 29 stands rejected under 35 U.S.C § 103(a) as unpatentable over the combination of Cauthen, Thompson, and Gruskin is affirmed. The rejection of claim 30 under 35 U.S.C § 103(a) as unpatentable over the combination of Cauthen, Thompson, and Mansouri is affirmed.

TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

cdc

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